

## **REMARKS/ARGUMENTS**

Responsive to the Office Action dated December 7, 2006, Applicant has amended Claim 1.

Accordingly, Claims 1-5 and 7 remain pending for prosecution with Claim 1 being independent.

### **I. Rejection of Claims 1, 2, 4, 5 and 7 over Rackley in view of Groomes**

Claims 1, 2, 4, 5 and 7 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,078,566 to Rackley in view of U.S. Patent No. 3,871,519 to Groomes. For the following reasons, Applicant respectfully requests reconsideration and withdrawal of this rejection.

The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. *MPEP* §2142. To establish a *prima facie* case of obviousness, three criteria must be met. First, there must be some suggestion or motivation, to modify the references or to combine reference teachings. Second, there must be reasonable expectation of success. Finally, the prior art must teach all the claim limitations. *MPEP* §2142. The teaching or suggestion to make the claim combination and the reasonable expectation of success must both be found in the prior art, and not based on applicants' disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Applicant respectfully submits that a *prima facie* case of obviousness has not been established because both Rackley and Groomes, individually and in combination, fail to teach or suggest the claimed invention.

It is asserted that Rackley discloses a case 10 for carrying and storing circular saw comprising at least two trays 11, 12 provided with inserts 34, 36 that alter the inside diameter of the said at least two trays for limiting movement of a circular saw blade. Applicant respectfully traverses this assertion and submits that Rackley fails to teach or suggest the claimed invention. First, Rackley does not teach or suggest the presence of a circular saw blade within the case. Second, the case disclosed in Rackley consists only of a single tray not two trays as claimed by Applicant. The two halves of Rackley's case come together to form one cavity; therefore, the case only consists of one tray with two halves. It is

asserted in the Office Action that “[w]hile one can construe the entire case a tray there is nothing preventing one from also construing each case section, which is defined to include a cavity, as also being a tray.” Applicant respectfully submits that the specification of Rackley itself does not support this conclusion. Rackley’s rotary saw blade housing apparatus is described as comprising a “housing structure including a housing base 11 hingedly mounted to a housing lid 12.” Rackley clearly defines the patented rotary saw blade case as having a separate base and lid - there is no contemplation that the lid be considered a separate “tray.” Furthermore, unlike the saw blades that are stored in the present invention, which consists of multiple trays that separate the blades individually, the blades stored in the case disclosed in Rackley are not separated and thus can become dull and damaged through contact with one another.

Third, the tubular bosses disclosed in Rackley do not act as annular inserts. Unlike the annular inserts in the present invention, Rackley’s inserts do not alter the diameter of the storage tray in order to limit the movement of the saw blades. Further, they are not removable and therefore cannot be defined as inserts. It is asserted in the Office Action that there is nothing in the claim requiring the inserts to be removable, Applicant has amended Claim 1 accordingly. Moreover, the Office Action asserts that “it is not seen what would prevent one from removing the mounted bosses, as by cutting them off, if so desired.” Applicant respectfully submits that that, by removing the mounted bosses of Rackley (as by cutting them off), the rotary saw blade housing of Rackley would be rendered inoperable and, therefore, this proposed modification to Rackley cannot be supported. Thus, Rackley fails to teach or suggest a generally circular case for carrying and storing circular saw blades including at least one circular saw blade, at least two storage trays, and a removable annular insert within the at least two storage trays wherein the insert alters a diameter of the at least two storage trays for limiting movement of a circular saw blade stored therein.

Similarly, Groomes does not teach or suggest the claimed invention. Groomes does not teach or suggest a generally circular case for carrying and storing circular saw blades including at least one circular saw blade, at least two storage trays, and a removable annular insert within the at least two storage trays wherein the insert alters a diameter of the at least two storage trays for limiting movement of a circular saw blade stored therein. Moreover, Applicant submits that Groomes, which is asserted as disclosing a “generally circular” case, is nonanalogous art and should not be combined with Rackley. “In order to rely on a reference as a basis for rejection of an applicant’s invention, the reference must either be in the field of applicant’s endeavor or, if not, then be reasonably pertinent to the particular problem with which the invention was concerned.” In re Oetiker, 24 USPQ2d 1443 (Fed. Cir. 1992). Applicant’s field of endeavor is a carrying case for circular saw blades. Groomes is directed to a bingo carrying case. Groomes is therefore clearly not within Applicant’s field of endeavor. Further, Groomes is not reasonably pertinent to the particular problem with which the present invention is concerned. The particular problem solved by the present invention is to provide a carrying case for circular saw blades that protects the user as well as the saw blades stored therein. Groomes’ bingo case has absolutely nothing to do with protecting saw blades from damage and it is unlikely in the extreme that one of ordinary skill in the art would have looked to a bingo case for inspiration in solving the problem at hand, namely, protecting saw blades from damage while simultaneously providing a safe carrying case therefor. Thus, there is no motivation to combine Rackley and Groomes.

Prima facie obviousness requires that there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references. No such suggestion or motivation exists in Rackley or Groomes to provide a generally circular case for carrying and storing circular saw blades including at least one circular saw blade, at least two storage trays, and a removable annular insert within the at least two storage trays, wherein the insert

alters a diameter of the at least two storage trays for limiting movement of a circular saw blade stored therein as claimed in the present invention. Moreover, there is no expectation of success in the combination of Rackley and Groomes because neither of these references teach or suggest all of Applicant's claim limitations. In particular, neither of these references teach or suggest a generally circular case having at least one circular saw blade, at least two storage trays and diameter-altering inserts therein. Unless all the elements are taught by the references, there can be no success in modifying them.

Thus, at the time the present invention was made, Rackley and Groomes, alone or in combination, both fail to teach or describe all of the limitations claimed by Applicant in independent Claim 1 and the claims depending therefrom. Accordingly, Claims 1, 2, 4, 5 and 7 are nonobvious under § 103(a).

## **II. Rejection of Claim 3 over Rackley in view of Groomes and further in view of Leitner**

Claim 3 was rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,078,566 to Rackley in view of U.S. Patent No. 3,871,519 to Groomes and further in view of U.S. Patent No. 2,410,585 to Leitner. For the following reasons, Applicant respectfully requests reconsideration and withdrawal of this rejection.

The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. *MPEP* §2142. To establish a *prima facie* case of obviousness, three criteria must be met. First, there must be some suggestion or motivation, to modify the references or to combine reference teachings. Second, there must be reasonable expectation of success. Finally, the prior art must teach all the claim limitations. *MPEP* §2142. The teaching or suggestion to make the claim combination and the reasonable expectation of success must both be found in the prior art, and not based on applicants' disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Applicant respectfully submits that a *prima facie* case of obviousness has not been established because Rackley, Groomes, and Leitner, individually and in combination, all fail to teach or suggest the claimed invention.

It is asserted that Rackley discloses a case 10 for carrying and storing circular saw comprising at least two trays 11, 12 provided with inserts 34, 36 that alter the inside diameter of the said at least two trays for limiting movement of a circular saw blade. Applicant respectfully traverses this assertion and submits that Rackley fails to teach or suggest the claimed invention. First, Rackley does not teach or suggest the presence of a circular saw blade within the case. Second, the case disclosed in Rackley consists only of a single tray not two trays as claimed by Applicant. The two halves of Rackley's case come together to form one cavity; therefore, the case only consists of one tray with two halves. It is asserted in the Office Action that “[w]hile one can construe the entire case a tray there is nothing preventing one from also construing each case section, which is defined to include a cavity, as also being a tray.” Applicant respectfully submits that the specification of Rackley itself does not support this conclusion. Rackley's rotary saw blade housing apparatus is described as comprising a “housing structure including a housing base 11 hingedly mounted to a housing lid 12.” Rackley clearly defines the patented rotary saw blade case as having a separate base and lid - there is no contemplation that the lid be considered a separate “tray.” Furthermore, unlike the saw blades that are stored in the present invention, which consists of multiple trays that separate the blades individually, the blades stored in the case disclosed in Rackley are not separated and thus can become dull and damaged through contact with one another.

Third, the tubular bosses disclosed in Rackley do not act as annular inserts. Unlike the annular inserts in the present invention, Rackley's inserts do not alter the diameter of the storage tray in order to limit the movement of the saw blades. Further, they are not removable and therefore cannot be defined as inserts. It is asserted in the Office Action that there is nothing in the claim requiring the inserts to be removable, Applicant has amended Claim 1 accordingly. Moreover, the Office Action asserts that “it is not seen what would prevent one from removing the mounted bosses, as by cutting them off, if so

desired.” Applicant respectfully submits that that, by removing the mounted bosses of Rackley (as by cutting them off), the rotary saw blade housing of Rackley would be rendered inoperable and, therefore, this proposed modification to Rackley cannot be supported. Thus, Rackley fails to teach or suggest a generally circular case for carrying and storing circular saw blades including at least one circular saw blade, at least two storage trays, and a removable annular insert within the at least two storage trays wherein the insert alters a diameter of the at least two storage trays for limiting movement of a circular saw blade stored therein.

Similarly, Groomes does not teach or suggest the claimed invention. Groomes does not teach or suggest a generally circular case for carrying and storing circular saw blades including at least one circular saw blade, at least two storage trays, and a removable annular insert within the at least two storage trays wherein the insert alters a diameter of the at least two storage trays for limiting movement of a circular saw blade stored therein. Moreover, Applicant submits that Groomes, which is asserted as disclosing a “generally circular” case, is nonanalogous art and should not be combined with Rackley. “In order to rely on a reference as a basis for rejection of an applicant’s invention, the reference must either be in the field of applicant’s endeavor or, if not, then be reasonably pertinent to the particular problem with which the invention was concerned.” In re Oetiker, 24 USPQ2d 1443 (Fed. Cir. 1992). Applicant’s field of endeavor is a carrying case for circular saw blades. Groomes is directed to a bingo carrying case. Groomes is therefore clearly not within Applicant’s field of endeavor. Further, Groomes is not reasonably pertinent to the particular problem with which the present invention is concerned. The particular problem solved by the present invention is to provide a carrying case for circular saw blades that protects the user as well as the saw blades stored therein. Groomes’ bingo case has absolutely nothing to do with protecting saw blades from damage and it is unlikely in the extreme that one of ordinary skill in the art would have looked to a bingo case for inspiration in solving the problem at hand,

namely, protecting saw blades from damage while simultaneously providing a safe carrying case therefor. Thus, there is no motivation to combine Rackley and Groomes.

Moreover, Leitner also fails to teach or suggest the claimed invention. Leitner does not teach or suggest a generally circular case for carrying and storing circular saw blades including at least one circular saw blade, at least two storage trays, and a removable annular insert within the at least two storage trays wherein the insert alters a diameter of the at least two storage trays for limiting movement of a circular saw blade stored therein. Moreover, Applicant submits that Leitner, which is asserted as disclosing a “generally circular” case with hinged case sections, is nonanalogous art and should not be combined with Rackley or Groomes. “In order to rely on a reference as a basis for rejection of an applicant’s invention, the reference must either be in the field of applicant’s endeavor or, if not, then be reasonably pertinent to the particular problem with which the invention was concerned.” *In re Oetiker*, 24 USPQ2d 1443 (Fed. Cir. 1992). Applicant’s field of endeavor is a carrying case for circular saw blades. Leitner is directed to a leak proof powder makeup case. Leitner is therefore clearly not within Applicant’s field of endeavor. Further, Leitner is not reasonably pertinent to the particular problem with which the present invention is concerned. The particular problem solved by the present invention is to provide a carrying case for circular saw blades that protects the user as well as the saw blades stored therein. Leitner’s powder case has absolutely nothing to do with protecting saw blades from damage and it is unlikely in the extreme that one of ordinary skill in the art would have looked to a powder case for inspiration in solving the problem at hand, namely, protecting saw blades from damage while simultaneously providing a safe carrying case therefor. Thus, there is no motivation to combine Rackley, Groomes or Leitner.

Prima facie obviousness requires that there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify

the references. No such suggestion or motivation exists in Rackley, Groomes or Leitner to provide a generally circular case for carrying and storing circular saw blades including at least one circular saw blade, at least two storage trays, and a removable annular insert within the at least two storage trays, wherein the insert alters a diameter of the at least two storage trays for limiting movement of a circular saw blade stored therein as claimed in the present invention. Moreover, there is no expectation of success in the combination of Rackley, Groomes and Leitner because none of these references teach or suggest all of Applicant's claim limitations. In particular, none of these references teach or suggest a generally circular case having at least one circular saw blade, at least two storage trays and diameter-altering inserts therein. Unless all the elements are taught by the references, there can be no success in modifying them.

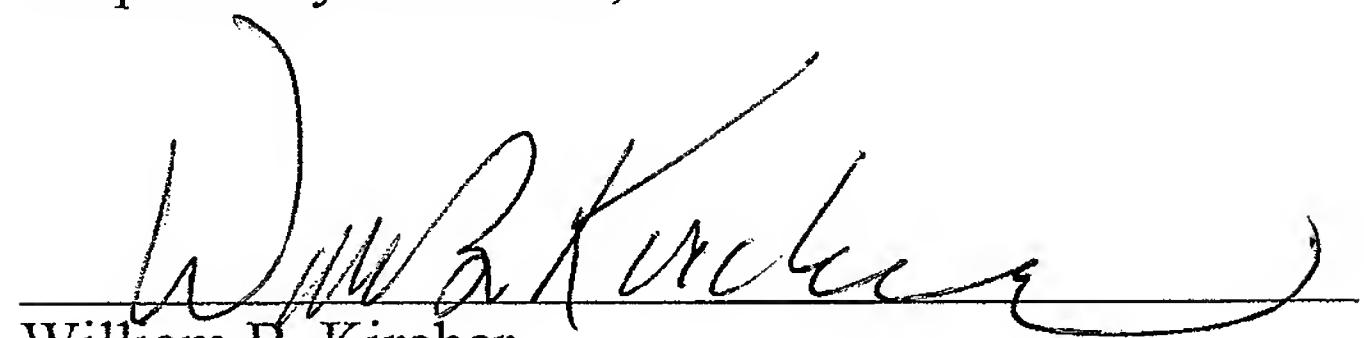
Thus, at the time the present invention was made, Rackley, Groomes, and Leitner alone or in combination, both fail to teach or describe all of the limitations claimed by Applicant in independent Claim 1 and the claims depending therefrom. Accordingly, Claim 3 is nonobvious under § 103(a).

### **III. Conclusion**

Applicant respectfully submits that the claims, as amended, are now in condition for allowance and such is courteously solicited. If any issue regarding the allowability of any of the pending claims in the present application could be readily resolved, or if other action could be taken to further advance this application such as an Examiner's amendment, or if the Examiner should have any questions regarding the present amendment, it is respectfully requested that the Examiner please telephone Applicant's undersigned attorney in this regard. The Examiner's attention is respectfully drawn to the correct attorney docket number shown in the header and on the first page of this response. The Commissioner is hereby authorized to deduct any necessary fees or credit any overpayment of fees in this application to Deposit Account No. 11-0160.

Respectfully submitted,

Date: 3/6/2007

  
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